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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/619,180

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EXAMINER

WEBB, SARAH K

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,180

Applicant(s)

KELLER, ARNOLD

Examiner

Sarah K Webb

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: Lines 1 and 2 state “an insertion instrument... comprising” and then line 5 states “an insertion instrument comprising...” It is confusing to name certain parts of an invention with the name of the entire apparatus. Examiner suggests simply deleting “an insertion instrument comprising” from line 5. Lines 4 and 5, for example, would then read:

“...closure plates,
a handgrip part, gripping members...”

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In lines 10-11, claim 1 states “projections pointing in a tensioning direction **OR** recesses for holding the intervertebral endoprosthesis...”

This is indefinite because it is unclear which structure should be included in the claimed invention. Further, claim 8 recites “the projections.” This is indefinite because claim 1 states that the structure could be recesses instead of projections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,431,658 to Moskovich.

Moskovich discloses an intervertebral prosthesis insertion tool that meets the limitations of claim 1. The device includes two closure plates (11,12) connected by a hinge (13), as illustrated in Figure 4. The plates have gripping members with grooved surfaces (shown in Figure 3) for supporting the prosthesis (column 3, lines 1-7). The proximal ends of the plates are capable of functioning as handgrips. Moskovich further explains here that the surface could have raised ridges. Figure 6 shows the hinged gripping plates (1,2) connected to an actuating device (21), which includes a threaded rod (25) with a handle (22) that could also function as a force receiving part or “strike head.” A block (26) at the end of the rod is positioned between the gripping members (1,2) and is moved longitudinally by the actuating device (21) to bear on a prosthesis (5) (column 3, lines 36-38). The insertion instrument could be described as “forceps.” Nut (23) includes a counter thread for receiving the rod (25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskovich in view of US Patent No. 3,960,147 to Murray.

Moskovich includes all the limitations of claims 4 and 5, except for positioning the threaded nut (23) within the hinge. Murray discloses another forceps type instrument that includes two hinged gripping members (18,19) and a threaded actuating rod (26). Murray teaches by illustration that a counter threaded part (25) that receives a threaded actuating rod may be positioned in the hinge (24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to arrange the hinge and threaded nut of Moskovich so the threaded nut is positioned within the hinge, as Murray teaches that this is another way to form a forceps with a threaded actuating rod.

5. Claims 7,9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskovich in view of US Patent No. 5,720,751 to Jackson.

Moskovich includes all the limitations of claims 7,9 and 11, except for a locking device with a guide for the actuating rod. Jackson discloses another type of implant grasping device in that includes hinged members and a threaded actuation rod (5) attached to an implant abutment part (20). Figure 24 illustrates an embodiment of the invention that includes a toothed locking device (290,289) for securing the handgrip

Art Unit: 3731

parts (286,287) pressed together (column 15, lines 34-42). One toothed member (289) of the locking device includes a receptacle (292) with a threaded bore for guiding the actuating rod (5) (column 15, line 46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a locking device with a threaded bore on the gripping plates (1,2) of Moskovich, as Jackson teaches that this structure aids the surgeon in securing the hinged members in a closed position.

6. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskovich in view of US Patent Application Pub. 2002/0072752; Zucherman et al.

Moskovich includes all the limitations of claims 8 and 10, except for the projections being arranged on removable jaw inserts. Zucherman discloses another type of instrument that also performs the function of distracting vertebrae. Zucherman teaches that gripping members with projections can be formed as detachable inserts [0048]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the gripping members of Moskovich as detachable inserts, as Zucherman teaches that this is another way to form a vertebrae distracting instrument.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moskovich modified by Zucherman, as applied to claim 8 above, and further in view of Jackson.

Moskovich includes all the limitations of claim 8, except for a locking device with a guide for the actuating rod. Jackson discloses an implant insertion device in that includes hinged members and a threaded actuation rod (5) that abuts an implant.

Art Unit: 3731

Figure 24 illustrates an embodiment of the invention that includes a toothed locking device (290,289) for securing the handgrip parts (286,287) pressed together (column 15, lines 34-42). One toothed member (289) of the locking device includes a receptacle (292) with a threaded bore for guiding the actuating rod (5) (column 15, line 46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a locking device with a threaded bore on the gripping plates (1,2) of Moskovich, as Jackson teaches that this structure aids the surgeon in securing the hinged members in a closed position.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 6,478,800 (Fraser et al.) discloses a device with hinged arms with a sliding implant engaging block actuated by a rod.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K Webb whose telephone number is (703) 605-1176. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott or Shaver can be reached on (703) 308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SKW
06/25/04

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DAVID O. REIP
PRIMARY EXAMINER